

**III. 35 U.S.C. § 102(e)–Anticipation–Creighton et al.**

The Office action has rejected claims 1, 2, 5, 8, 11, 12, 15, 18, 21, 22, 25, 28 under 35 U.S.C. § 102(e) as anticipated by Creighton et al., "Systems and methods for secured electronic transactions", U.S. Patent Application Number 2002/0035686, filed 07/14/2000, issued 03/21/2002. This rejection is respectfully traversed.

Independent claims 1, 11, and 21 have been amended to incorporate features from two dependent claims, said features previously included within claims 5, 8, 15, 18, 25, and 28, which are now canceled; for example, claims 5 and 8 have been canceled while incorporating their subject matter into independent claim 1. The independent claims, as amended, contain the feature of prompting the user for authentication data, such as a username/password pair or other authentication data, which is then included the PKI credential request that is sent to a certificate issuing authority; the prompting operation is performed in response to receiving the pre-registration record that initiates the process for obtaining PKI credentials. In addition, the independent claims, as amended, also contain the feature of receiving at least a public key certificate and an attribute certificate when the PKI credentials are received, and the attribute certificate contains the user-provided authentication data.

With respect to dependent claims 5, 15, and 25, along with dependent claims 8, 18, and 28, the rejection states that Creighton et al. at paragraphs 36 and 37 discloses the claimed features concerning an attribute certificate that is received in response to the PKI credential request, wherein the attribute certificate contains user-provided authentication data. Applicant strongly disagrees. Creighton et al. does not disclose the use of attribute certificates in any manner.

Paragraphs 36 and 37 state:

[0036] The certification authority authenticates the RA and sets up the RA in the certification authority system, according to step 310. The set-up includes entering RA information in the computer and giving access to the RA to a registration interface to establish registration individuals (RIs), according to step 310. The RIs can then securely access a registration graphical user interface (GUI) in a secured web site offered by the certification authority and register employees, for example, by uploading an excel spreadsheet or using an HTML form, according to step 315. The certification authority system generates a user identification code and a personal identity number (PIN), stores them in the database, and creates a PDF (portable document format) form for each registered employee, according to step 320. This is preferably done in real time. The RI's can download the PDF form with the pre-registration information, according to step 330, and securely deliver it, for example, in a sealed envelope to that employee, according to step 335. The delivery of the PDF form can also be done through other secure electronic transmissions. The employee can then make a certificate request via the secured web site provided by the certification authority, according to step 340. The employees are asked to enter their user identification code and PIN and also enter registration information, for example using an HTML form. As an additional authentication step a determination is then made whether the employee's pre-registration information stored in the certificate database matches the pre-registration information entered into the request, according to block 345. If it matches, then a digital certificate is created and e-mailed to the employee, according to block 350. If the information in the request does not match the stored pre-registration information, then the request is denied, according to block

355. Fulfillment of the whole process will typically take less than a few minutes to be completed, generally less than about three minutes.

5 [0037] A digital certificate issued to an authenticated employee may contain among other information the employee's identification information, the company's information, the level of authority, typically expressed in terms of dollar, granted by the company to this employee, etc. The company  
10 can determine what information to include in a digital certificate by providing this information to the certification authority while pre-registering the employee.

As should be apparent by reference to paragraph 37 et al.,  
15 Creighton et al. generally discloses a digital certificate is generated and returned to a user for the purposes of engaging in secure electronic transactions. Creighton et al. does not specify any detail of the type of digital certificate that might be returned, and Creighton et al. implies that a public key  
20 certificate is the only type of digital certificate that is returned. Again, Creighton et al. does not disclose the use of attribute certificates in any manner.

In contrast, the user in the present invention obtains multiple digital certificates in response to a single PKI  
25 credential request. In addition, the user in the present invention receives an attribute certificate along with a public key certificate. These features are clearly claimed in the independent claims, as amended.

Moreover, although Creighton et al. discloses a set of  
30 steps in which a user enters authentication data during the process to obtain a digital certificate, the authentication data is used by the certification authority to authenticate the user prior to creating and returning a digital certificate. As disclosed in paragraph 36:

35 The employees are asked to enter their user identification code and PIN and also enter registration information, for example using an HTML form. As an additional authentication

step a determination is then made whether the employee's pre-registration information stored in the certificate database matches the pre-registration information entered into the request, according to block 345. If it matches, then a digital certificate is created and e-mailed to the employee, according to block 350.

In addition, as stated in paragraph 36, "the certification authority generates a user identification code and a personal identity number (PIN)". In other words, the authentication data that is entered by the user and then used by the certification authority has a special, one-time purpose, i.e. to verify that the user that returns the request for the digital certificate is a user that has been properly referred by the registration authority back to the certification authority for a digital certificate.

In contrast, the user in the present invention enters authentication data for the purposes of providing the authentication data that will be embedded within the attribute certificate that is returned to the user. These features are clearly claimed in the independent claims, as amended.

Creighton et al. clearly does not disclose features as required by the language of the amended independent claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Creighton et al. cannot be used as an anticipatory reference, and the

anticipatory rejections of the claims have been overcome,  
whereby Applicant requests the withdrawal of the rejections.

**IV. 35 U.S.C. § 103(a)–Obviousness**

5           The Office action has rejected claims 3, 9, 13, 19, 23, and  
29 under 35 U.S.C. § 103(a) as unpatentable over Creighton et al.  
in view of Padgett et al., "Digital Signature Providing Non-  
Repudiation Based on Biological Indicia", U.S. Patent Number  
6,535,978 B1, filed 07/28/1998, issued 03/18/2003. This  
10       rejection is traversed.

          The Office action has also rejected claims 4, 10, 14, 20,  
24, and 30 under 35 U.S.C. § 103(a) as unpatentable over  
Creighton et al. in view of Brown et al., "System and method for  
document-driven processing of digitally-signed electronic  
15       documents", U.S. Patent Number 6,671,805 B1, filed 06/17/1999,  
issued 12/30/2003. This rejection is also traversed.

          The Office action has also rejected claims 6, 16, and 26  
under 35 U.S.C. § 103(a) as unpatentable over Creighton et al. in  
view of Schneider, "Method, product, and apparatus for  
20       delivering a message", U.S. Patent Application Number  
2002/0010745, filed 12/08/2000, issued 01/24/2002. This  
rejection is also traversed.

          The Office action has also rejected claims 7, 17, and 27  
under 35 U.S.C. § 103(a) as unpatentable over Creighton et al. in  
25       view of Stewart et al., "Network communication service with an  
improved subscriber model using digital certificates", U.S.  
Patent Number 6,571,221 B1, filed 11/03/1999, issued 05/27/2003.  
This rejection is also traversed.

          The Office action has rejected some of the dependent claims  
30       using obviousness arguments based on Creighton et al. as a  
primary reference and a set of secondary references. The

dependent claims contains various features, such as the manner in which the PKI credentials are stored upon receipt.

Creighton et al. was used as the basis for an anticipatory rejection of the independent claims. In response, Applicant has amended the independent claims to include features that are not disclosed within Creighton et al. nor within any of the prior art references that have been used as secondary references within the obviousness rejections. Thus, the applied prior art cannot be combined to reach the claimed features of the present invention.

Examiner bears the burden of establishing a *prima facie* case of obviousness

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

The applied prior art references clearly fail to disclose at least one feature of the present invention as recited within each independent claim, notwithstanding the obviousness arguments presented by the Office action, thereby rendering the applied prior art references incapable of being used as primary and secondary references as argued by the current rejection. Moreover, a hypothetical combination of the applied prior art references would also fail to reach the claimed invention of the present patent application. As should be recognized, because the applied prior art references in the rejections fail to disclose the claimed features against which the references were applied, and because the references fail to be combinable to produce these claimed features, the rejection fails to fulfill the requirements of a proper obviousness argument.

With respect to the claims of the present patent application, Applicant respectfully submits that it would not have been obvious for one having ordinary skill in the art to have used the applied prior art references to reach the claimed invention. Hence, a rejection of the claims cannot be based upon the cited prior art to establish a *prima facie* case of obviousness. Therefore, a rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable in view of the cited prior art, and the claims are patentable over the applied references. Applicant respectfully requests the withdrawal of the rejection of the claims.

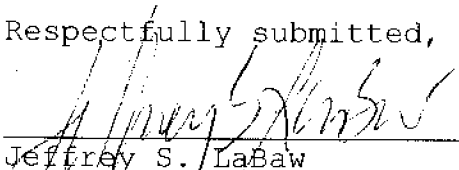
**V. Conclusion**

It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a  
5 Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

10 DATE: September 27, 2006

Respectfully submitted,

  
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15 ATTORNEY FOR APPLICANT